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May 18, 2006

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**RE:** 09/981,885

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VERBUNT-PACARD COMPANY  
Intellectual Property Administration  
P.O. Box 272408  
Fort Collins, Colorado 80527-2408

PATENT APPLICATION  
ATTORNEY DOCKET NO. 10013715-1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner(s): Robert Holmes Confirmation No.: 1001  
Application No.: 02/394,843 Examiner: Tamm Claps  
Filing Date: Oct. 17, 2001 Group & Art Unit: 1776

Title: Media Involving With Media Parameter Information

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**Amended Appeal Brief**  
~~TRANSMITTAL OF OFFICE ACTION~~

Transmitted herewith is the Appeal Brief in the application with respect to the Notice of Appeal filed on Feb. 10, 2003.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$ 00.00.

Complete (a) or (b) as applicable:

The proceedings herein are for a patent application and the provisions of 37 CFR 1.156(a) apply.

☐ (a) Applicant prays for an extension of time under 37 CFR 1.130 (Recs. 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month \$120 ☐ 2nd Month \$400 ☐ 3rd Month \$1000 ☐ 4th Month \$1600

☐ The extension fee has already been paid in this application.

☐ (b) Applicant believes that no extension of time is required. However, his conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 09-0225 the sum of \$ 00.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 09-0225 pursuant to 37 CFR 1.22. Additionally please charge any fees to Deposit Account 09-0225 under 37 CFR 1.10 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may require fees. A duplicate copy of this sheet is enclosed.

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Date of forward: May 18, 2006  
Typed Name: J. Ormiston  
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Respectfully submitted,  
Robert Holmes  
By: [Signature]  
Robert A. Ormiston  
Attorney/Agent for Applicant(s)  
Reg No.: 33574  
Date: May 18, 2006  
Telephone: 304-23-1221

PAGE 013 \* RCVD AT 5/18/2006 2:27:26 PM [Eastern Daylight Time] \* SVR:USPTO-EFAX-5/21 \* DNIS:2731519 \* CSID:208 433 9295 \* DURATION (mm-ss):03-26

HEWLETT-PACKARD COMPANY  
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Fort Collins, Colorado 80527-2400

## PATENT APPLICATION

ATTORNEY DOCKET NO. 10013718-1IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert Haines

Confirmation No.: 7082

Application No.: 09/981,885

Examiner: Tamra Dicus

Filing Date: Oct. 17, 2001

Group Art Unit: 1774

Title: Media Imprinting With Media Paramotor Information

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*Amended Appeal Brief*  
**TRANSMITTAL OF APPEAL BRIEF**

*Amended Appeal Brief*Transmitted herewith is the ~~Appeal Brief~~ in this application with respect to the Notice of Appeal filed on Feb. 10, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$ 00.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month  
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Typed Name: Joanna Keyt

Signature: 

Respectfully submitted,

Robert Haines

By 

Steven R. Ormiston

Attorney/Agent for Applicant(s)

Reg No. : 35,974

Date : May 18, 2006

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Rev 10/05 (Ap/Brief)

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10013718-1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert Haines  
Application No.: 09/981,885  
Filing Date: Oct. 17, 2001

Confirmation No.: 7082  
Examiner: Tamra Dicus  
Group Art Unit: 1774

Title: Media Imprinting With Media Parameter Information

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*Amended Appeal Brief*  
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*Amended Appeal Brief*

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on Feb. 10, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$ 00.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month  
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\$1590

☐ The extension fee has already been filed in this application.

☐ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ .00 . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

Robert Haines

By 

Steven R. Ormiston

Attorney/Agent for Applicant(s)

Reg No.: 35,974

Date: May 18, 2006

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IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Robert Haines

ATT. DOCKET NO.: 10013718-1

SERIAL NO.: 09/981,885

GROUP ART UNIT: 1774

FILED: October 17, 2001

EXAMINER: Tamra Dicus

TITLE: Media Imprinted With Media Parameter Information

**APPELLANT'S/APPLICANT'S OPENING BRIEF ON APPEAL (AMENDED)**

This amended Brief is submitted to withdraw from the appeal certain claims whose allowability may be affected by the Nydberg reference (WO 200016982) recently cited in a divisional to this application (serial no. 10/732,636).

**1. REAL PARTY IN INTEREST.**

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

**2. RELATED APPEALS AND INTERFERENCES.**

There are no other appeals or interferences known to Appellant, Appellant's legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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**3. STATUS OF CLAIMS.**

Claims 1, 3-5, 32-34, 38-39 and 41-43 are pending. Claims 2, 6-31, 35-37 and 40 have been canceled. The rejection of Claim 39 is appealed. (The rejection of the other pending claims is not appealed.) Only the appealed claim is listed in Appendix I.

**4. STATUS OF AMENDMENTS.**

No amendments to the claims were filed after the final action.

**5. SUMMARY OF CLAIMED SUBJECT MATTER.**

The appealed claim relates to printer sheet media marked on an edge and on a face with information that may be used to configure a printer or other imaging device.

Claim 39, for example, is directed to a stack of print media sheets, each sheet in the stack being skewed at an angle with respect to the next sheet in the stack such that a portion of a face of each sheet is exposed (e.g., stack 402 and sheets 100 in Fig. 4 and Specification page 7, lines 9-18), and a fluid-based marking on the exposed face of each sheet and on an adjoining edge of each sheet, the marking continuous from the face of each sheet to the edge of each sheet and the marking representing machine readable data for configuring an imaging device for printing on the sheets in the stack (e.g., marking 102 in Figs. 1 and 2 and Specification, page 5, line 15 through page 6, line 6 and page 10, lines 4-10).

**6. GROUNDS OF REJECTION TO BE REVIEWED.**

1. The recitation of a marking representing machine readable data for configuring an imaging device for printing is not indefinite. Ground No. 1 applies to the Section 112 rejection of Claim 39.

2. The recitation of a marking continuous from the face of the sheet to the edge is not indefinite. Ground No. 2 applies to the Section 112 rejection of Claim 39.

3. Neither Brinkman patent teaches a marking representing machine readable data for configuring an imaging device for printing on the sheet or machine readable parameters corresponding to the sheet. Ground No. 3 applies to the Section 103 rejection of Claim 39.

4. The recitation of a marking representing machine readable data for configuring an imaging device for printing is not a recitation of intended use that the

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Examiner may ignore when determining patentability. Ground No. 4 applies to the Section 103 rejection of Claim 39.

5. Claim 39 is not a product-by-process claim. Ground No. 5 applies to the Section 103 rejection of Claim 39.

7. ARGUMENT.

**GROUND NO. 1**

**The recitation of a marking representing machine readable data for configuring an imaging device for printing is not indefinite.  
(Claim 39)**

Claim 39 was rejected under Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 39 recites "a fluid-based marking ... representing machine readable data for configuring an imaging device for printing on the sheets in the stack."

In support of the rejection, the Examiner makes the following statements.

"Claims 1 and 39 recite 'the single fluid-based marking comprises data for configuring an imaging device', and 'the data is for configuring the image device to form images on the sheet', respectively, however, Applicant's specification on page 9, lines 17-19 recite the image forming device is configured to form images upon print media. Thus it is not clear how said marking comprises data for configuring an image device or how data configures an image device. Further, to say 'configure' is vague and confusing. How does fluid ink 'configure' a device, or image device? Does ink turn on the image device? How and what steps are involved to 'configure' a fluid-based marking to an image device?" Final Office Action, page 2.

According to the MPEP, the essential inquiry for this part of Section 112 is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed in light of the Specification, the teachings of the prior art, and the interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. MPEP 2173.02, citing *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

Claim 39 recites a marking representing machine readable data. A typical bar code, for example, is one such marking. Bar codes, of course, are well known to

everyone, including those having ordinary skill in the printer arts. Claim 39 recites that the data represented by the marking is for configuring an imaging device for printing on sheets bearing the marking. The bar code shown in detail in Fig. 2, for a specific example, is a marking representing machine readable data such as the media parameters listed in the Specification at page 5, lines 15-24 (e.g., type of media, size, thickness, feed speed, fusing temperature, drying time). One example of the use of such media parameters to configure an imaging device is described in the Specification at page 14, line 14 through page 15, line 5. This teaching in the Specification is consistent with the fact that it is well known in the printer arts that printers and other image forming devices may be configured for various printing tasks, including printing on different types of media.

Appellant respectfully submits, therefore, that the language of Claim 39 when analyzed in light of the Specification sets out and circumscribes the particular subject matter with a reasonable degree of clarity and particularity. It necessarily follows that unless and until the Examiner can show something in the teachings of the prior art or an interpretation by someone having ordinary skill in the pertinent art that negates Appellant's showing, the Section 112 rejection of Claim 39 should be withdrawn.

#### **GROUND NO. 2**

**The recitation of a marking continuous from the face of the sheet to the edge is not indefinite.  
(Claim 39)**

Claim 39 was rejected under Section 112, second paragraph, as being indefinite. The Examiner asserts that the recitation of a marking continuous from the face of a sheet to the edge of the sheet is "not clear" because "[t]he marking is imprinted, thereby making it incapable of being continuous. Print operations imprint discontinuous markings." Final Office Action, page 2.

The Examiner's statement is not correct. Modern printers are capable of printing continuous markings. Long lines, for example, can be printed with both laser and inkjet printers. The lines in a printed bar code, for another example, are continuous markings, each of which may be continuous from the face of a sheet to the edge of the sheet as shown in Fig. 2. If the Examiner is suggesting that the pixels



that make up a printed marking are not, at a microscopic level, continuous, then she is respectfully requested to specifically so state and the Appellant will address the suggestion in a reply brief. If the Examiner is suggesting some other form of discontinuity, then a more detailed explanation is requested so the Appellant is not left to guess at the substance of the rejection.

### **GROUND NO. 3**

**Neither Brinkman patent teaches a marking representing machine readable data for configuring an imaging device for printing on the sheet or machine readable parameters corresponding to the sheet.  
(Claim 39)**

Claim 39 stands rejected under Section 103 as being obvious over Brinkman '027 or Brinkman '783. The rejection of Claim 39 is based on the assertion that both Brinkman patents teach a marking representing machine readable data for configuring an imaging device for printing on the sheet. Final Office Action, page 4. This assertion is not correct.

Claim 39 recites a fluid based marking representing machine readable data for configuring an imaging device for printing on the sheets in the stack. The various markings in Brinkman '027 represent machine readable data for the content, origin, destination or "other useful information about a parcel" or for pricing an item of merchandise. See, for example, Brinkman '027 column 4, lines 30-33 and 53-55; column 21, lines 7-10. Brinkman '783 does not expressly state the content of his machine readable parcel markings. It appears from the description of the parcels and the markings, however, that the markings represent data related to shipping a parcel and, perhaps related billing information. See, for example, Brinkman '783 column 3, lines 63-65.

The passages in each Brinkman cited by the Office as teaching this element of Claim 1 (Brinkman '027 Abstract and column 21, lines 10-20; Brinkman '783 Abstract and column 2, lines 22-35) clearly do not teach or even remotely suggest machine readable data for configuring an imaging device for printing on the sheet. The Examiner has been respectfully requested to specifically point out and explain those passages in either Brinkman patent that teach a marking representing machine readable data for configuring an imaging device for printing on the sheet, rather than

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simply quoting the claim element and then citing to a figure and passage in the reference that has no apparent relevance to the quoted claim element. In reply, the Examiner argues this limitation "is to intended use and is not germane to patentability." Final Office Action, page 9. The Examiner seems to concede, therefore, that Brinkman does not teach a marking representing machine readable data for configuring an imaging device for printing on the sheet.

The Examiner's "intended use" argument is addressed in Ground No. 4 below.

The cited art does not teach or suggest a marking representing machine readable data for configuring an imaging device for printing on the sheet as recited in Claim 39. The rejection of Claim 39 should be reversed.

#### **GROUND NO. 4**

**The recitation of a marking representing machine readable data for configuring an imaging device for printing is not a recitation of intended use that the Examiner may ignore when determining patentability.  
(Claim 39)**

Claim 39 recites a fluid based marking representing machine readable data for configuring an imaging device for printing on the sheet in the stack. The Examiner apparently does not give this limitation patentable weight because, the Examiner asserts, it "is to intended use and is not germane to patentability...." Final Office Action, page 9. This assertion is not correct.

While the disputed language may be deemed to have both structural and functional elements, it is not merely a recitation of intended use. The phrase "for configuring an imaging device" modifies "data." The marking represents this data. This is no less a structural limitation on the marking simply because it suggests the data will be used to configure an imaging device. To the extent "for configuring an imaging device" is deemed a functional limitation on the data, it is well settled that any such functional limitation is proper and must be accorded patentable weight. See e.g., *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430, 1433 (Fed. Cir. 1990); *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) ("members adapted to be positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly).

The Examiner made this same argument, but in more detail, prior to the first appeal in this case. While the Examiner does not cite to any legal authority now to support her position, earlier she relied on *Ex parte Masham*, 2 USPQ.2d 1647 (BPAI 1987). Any such reliance on *Masham* is misplaced now just as it was during earlier prosecution, as noted in the Appellant's brief in the first appeal. In *Masham*, the Board held that the recitation of the material intended to be worked on by a claimed apparatus does not impose any structural limitations which differentiate it from a prior art apparatus satisfying the structural limitations of the claim. The Board then went on to state more broadly (and quite unnecessarily) that the "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus ...." Even this broad language in *Masham* has never been construed as a ban on functional limitations. Rather, the holding in *Masham* is limited to statements of intended use for "a claimed apparatus." Claim 39 is directed to a stack of sheets that includes a fluid-based marking on each sheet -- an article of manufacture. The fluid-based marking representing data "for configuring an imaging device" is not a statement of intended use for "a claimed apparatus" or even the claimed article. Rather, it is a functional limitation that quite properly defines the data represented by marking.

#### **GROUND NO. 5**

#### **Claim 39 is not a product-by-process claim. (Claim 39)**

Claim 39 recites a stack of print media sheets, each sheet in the stack being skewed at an angle with respect to the next sheet in the stack such that a portion of a face of each sheet is exposed, and a fluid-based marking on the exposed face of each sheet and on an adjoining edge of each sheet. Neither Brinkman patent teaches these limitations, and the Examiner makes no assertion to the contrary. Rather, the Examiner asserts that Claim 39 includes process limitations that must be ignored in determining patentability. In support of the rejection of Claim 39, the Examiner states:

"To claim 39, how markings were generated by various process and that each of the sheets are being skewed at an angle are process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the

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invention defined by a product-by-process invention is a product NOT a process. In re Bridgeford, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. In re Brown, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same." Final Office Action, page 7 and page 8.

The Examiner has not identified a single process limitation in Claim 39. In fact, there are none.

Claim 39 recites "each sheet in the stack being skewed ... with respect to the next sheet." Claim 39 does not recite any particular process through which the sheets came to be skewed. Claim 39 requires only that the sheets are skewed.

Claim 39 recites a "marking on the exposed face of each sheet and on an adjoining edge of each sheet ...." Claim 39 does not recite any particular process through which the marking came to be on the exposed face and on an edge of each sheet. Claim 39 requires only that there be a marking on the exposed face of each sheet and on an adjoining edge of each sheet.

The Examiner is respectfully requested to specifically point out and explain those limitations in Claim 39 she feels are process limitations. Absent such a showing, the rejection of Claim 39 should be withdrawn.

Respectfully submitted,

/Steven R. Ormiston/

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09/981,885  
Attorney Docket No. 10013718-1  
Appellant's Opening Brief (Amended)  
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**APPENDIX I – CLAIMS INVOLVED IN THE APPEAL**

39. A stack of print media sheets, each sheet in the stack being skewed at an angle with respect to the next sheet in the stack such that a portion of a face of each sheet is exposed, and a fluid-based marking on the exposed face of each sheet and on an adjoining edge of each sheet, the marking continuous from the face of each sheet to the edge of each sheet and the marking representing machine readable data for configuring an imaging device for printing on the sheets in the stack.

**APPENDIX II – EVIDENCE SUBMITTED UNDER RULES 130, 131 OR 132**

none

**APPENDIX III – RELATED PROCEEDINGS**

none

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Attorney Docket No. 10013718-1  
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